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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,517

10/07/2005

Hiroshi Sekiya

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EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

05/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,517	Applicant(s) SEKIYA, HIROSHI	
	Examiner Mark Halpern	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21, 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/7/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1) Applicant's election with traverse of invention II, drawn on claims 11-21, 24, in the reply filed on 4/3/2008, is acknowledged. The traversal is on the ground(s) that the search for the two inventions is overlapping. This is not found persuasive as the inventions do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features: Claim 1 is either obvious over or anticipated by EP 1124006. Accordingly, the special feature linking the two inventions, a method of preventing contamination where an agent is applied to a paper web in a dryer system, does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, the restriction is appropriate.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-10, 22-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Specification

2) Specification paragraphs [0096] and [0131] recite synthetic oil including "silicon oil". It is not clear as to the recited "silicon oil" spelling instead of silicone oil.

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Claim Objections

3) Claims 11, 12, 17, 24 are objected. The claims should be rewritten in an independent form.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 11-21, 24, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Taichi Kuroda (JP 7-292382, copy of translated copy is provided).

Claims 11, 24: Taichi discloses a contamination prevention agent made of mineral oil that includes silicone oil in emulsion, the silicone oil component being up to 65 % (Abstract). The agent is used in paper machine drying process

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(Title, entire document). The claims are considered product-by-process claims since the claimed agent is obtained by emulsifying process.

In the event any differences can be shown for the product of the product-by-process claims 11, 24, as opposed to the product taught by the reference Taichi, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Claims 12-21: Taichi discloses a contamination prevention agent made of mineral oil that includes silicone oil in emulsion, the silicone oil component being up to 65 % (Abstract). The agent is used in paper machine drying process (Title, entire document). The agent is a copolymer that includes cationic monomer having ethylene double bond and anionic monomer having ethylene double bond, as for example, disclosed in paragraphs [0011]-[0015]. The claims are considered product-by-process claims since the claimed agent is obtained by polymerizing mixture of cationic monomer having ethylene double bond and anionic monomer having ethylene double bond.

In the event any differences can be shown for the product of the product-by-process claims 12-21, as opposed to the product taught by the reference Taichi, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5) Claims 11-21, 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-10 of copending Application No. 10/540,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and the copending application disclose a contamination preventive agent or an antipollution agent that includes synthetic oil that includes silicone oil.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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6) Claims 11-21, 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/501,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and the copending application disclose a contamination preventive agent that includes synthetic oil that includes silicone oil.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7) Claims 11-21, 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-21 of copending Application No. 10/546,345. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and the copending application disclose an agent that includes synthetic oil that includes silicone oil.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8) Claims 11-21, 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-16 of copending Application No. 10/522,648. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and the copending application disclose a contamination preventive agent that is an antipollution agent.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Halpern/
Primary Examiner
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